

### **REMARKS**

Applicants appreciate the Examiner's thorough examination of the present application as evidenced by the Office Action of April 5, 2004 (hereinafter "Office Action"). In response, Applicants have amended dependent Claims 6, 7, 41, and 42 so as to be in independent form. Moreover, Claims 6 and 41 have been further amended to clarify that the signals are radio frequency signals. Dependent Claims 8 and 43 have been amended to depend from Claims 6 and 41, respectively, and new dependent Claims 48 and 49, which are analogous to Claims 8 and 43 have been added to depend from Claims 7 and 42, respectively. Claims 1 - 5, 9 - 40, and 44 - 47 have been canceled without prejudice or disclaimer.

Applicants respectfully submit that the cited references do not disclose, teach, or suggest all of the recitations of independent Claims 6, 7, 41, and 42. Accordingly, Applicants submit that all pending claims are in condition for allowance. Favorable reconsideration of all pending claims is respectfully requested for at least the reasons discussed hereafter.

#### **Interview Summary**

Applicants wish to thank the Examiner for the interview with Applicants' representative, Scott Moore (Reg. No. 42,011), on January 21, 2004. Applicants concur with the Examiner's summary of the interview as set forth in the Interview Summary form PTOL-413, which is attached to the Office Action. Applicants note that the cancellation of Claims 13 - 26 in response to the restriction requirement of December 23, 2003 has been made without prejudice to the filing of a divisional application.

#### **The 35 U.S.C. §102(b) Rejections**

Claims 1 and 36 stand rejected as anticipated under 35 U.S.C. §102(b) by U. S. Patent No. 5,758,266 to Kornfeld et al. (hereinafter "Kornfeld"). In response, Applicants have canceled Claims 1 and 36 without prejudice or disclaimer.

#### **Claims 6 and 41 are Patentable**

Independent Claims 6 and 41 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kornfeld in view of U. S. Patent No. 6,606,485 to Chen et al. (hereinafter

"Chen"). Independent Claim 6 is directed towards a method of performing a mobile terminal hand-over in which radio frequency (RF) signals are received and filtered by the mobile terminal and the band of RF frequencies is sampled at a mobile terminal. For example, Claim 6 recites in part:

...  
filtering radio frequency (RF) signals received by the mobile terminal  
using a bandpass filter that passes frequencies corresponding to the  
communication band of contiguous communication channels;  
sampling the band of RF frequencies at the mobile terminal to detect a  
plurality of signals received from the plurality of base station transceivers,  
wherein respective ones of the plurality of received signals are associated with  
respective ones of the plurality of base station transceivers; and  
...

Claim 41 includes similar recitations. This aspect of the present invention is illustrated, for example, in FIG. 8 where the RF signals are shown to be bandpass filtered using bandpass filters 254 and 264 and then the RF frequencies are sampled using A/D converters 256 and 266 and sampling units 258 and 268.

The Office Action acknowledges that Kornfeld does not "teach using a bandpass filter that passes frequencies corresponding to the communication band of contiguous communication channels before sampling the communication band of contiguous communication channels at the mobile terminal," but alleges that Chen provides the missing teaching. (Office Action, page 5). In particular, the Office Action cites col. 5, lines 35 - 43 of Chen as teaching the sampling recitation of Claim 6. (Office Action, page 5). Applicants acknowledge that Chen describes the use of analog to digital converters 1125 (see FIG. 11) to sample a received signal. Applicants refer, however, to FIG. 11 of Chen where the receiver 1120 includes bandpass filters 221 and 224 along with a mixer 222 and local oscillator 223 to shift the incoming RF signal to a different frequency band. Thus, Chen does not describe or suggest sampling the band of RF frequencies as recited in Claims 6 and 41.

For at least the foregoing reasons, Applicants respectfully submit that independent Claims 6 and 41 are patentable over Kornfeld and Chen and that dependent Claims 8 and 43 are patentable at least by virtue of their depending from an allowable claim.

**Claims 7 and 42 are Patentable**

Independent Claims 7 and 42 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kornfeld in view of Chen. Independent Claim 7 is directed towards a method of performing a mobile terminal hand-over in which signals are received, filtered, and stepped down to a band of intermediate frequencies by a mobile terminal. The band of intermediate frequencies is sampled at the mobile terminal. For example, Claim 7 recites in part:

...  
filtering signals received by the mobile terminal using a bandpass filter that passes frequencies corresponding to the communication band of contiguous communication channels;  
stepping down signals received by the mobile terminal and passed by the bandpass filter from frequencies corresponding to the communication band of contiguous communication channels to a band of intermediate frequencies;  
sampling the band of intermediate frequencies at the mobile terminal to detect a plurality of signals received from the plurality of base station transceivers, wherein respective ones of the plurality of received signals are associated with respective ones of the plurality of base station transceivers;  
and  
...

Claim 42 includes similar recitations. This aspect of the present invention is illustrated, for example, in FIG. 7 where the intermediate frequency signals are shown to be bandpass filtered using bandpass filter 234 and then the intermediate frequencies are sampled using A/D converter 236 and sampling unit 238.

Similar to the rejection of Claims 6 and 41 discussed above, the Office Action cites col. 5, lines 35 - 43 of Chen as teaching the sampling recitation of Claim 7. (Office Action, page 6). Applicants acknowledge that Chen describes the use of analog to digital converters 1125 (see FIG. 11) to sample a received signal that has been shifted to a different frequency band as discussed above with respect to Claims 6 and 41. Applicants respectfully submit, however, that neither Kornfeld nor Chen include any motivation or suggestion to modify Kornfeld as indicated in the Office Action.

To establish a *prima facie* case of obviousness, the prior art reference must teach or suggest *all* the recitations of the claims, and there must be some suggestion or motivation,

either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. M.P.E.P. § 2143. The mere fact that references **can be modified** does not render the resultant combination obvious **unless the prior art also suggests the desirability of the modification**. M.P.E.P. § 2143.01(citing *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990)). There is no motivation or suggestion to modify the cited reference as suggested in the Office Action. As affirmed by the Court of Appeals for the Federal Circuit in *In re Sang-su Lee*, a factual question of motivation is material to patentability, **and cannot be resolved on subjective belief and unknown authority**. See *In re Sang-su Lee*, 277 F.3d 1338 (Fed. Cir. 2002). It is improper, in determining whether a person of ordinary skill would have been led to modify the reference, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 312-13 (Fed. Cir. 1983).

Applicants submit that nothing in Kornfeld or Chen provides any motivation to modify Kornfeld to sample the downconverted intermediate frequency signals in addition to sampling the baseband signals as is currently described in Kornfeld (Kornfeld, col. 6, lines 7 - 17) as such dual sampling would appear to serve no additional benefit. Applicants further submit that the rejection of Claims 7 and 42 based on the combination of Kornfeld and Chen appears to be based on impermissible hindsight gleaned from the recitations of Claims 7 and 42. According to the Court of Appeals for the Federal Circuit, "there must be some reason for the combination other than the hindsight gleaned from the invention itself." *Interconnect Planning Corp. v. Feil*, 774 P.2d 1132, 1143, 227 U.S.P.Q. 543 (Fed. Cir. 1985).

For at least the foregoing reasons, Applicants respectfully submit that independent Claim 7 and 42 are patentable over Kornfeld and Chen and that dependent Claims 48 and 49 are patentable at least by virtue of their depending from an allowable claim.

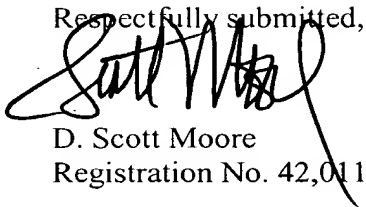
### CONCLUSION

In light of the above amendments and remarks, Applicants respectfully submit that the above-entitled application is now in condition for allowance. Favorable reconsideration of this application, as amended, is respectfully requested. If, in the opinion of the Examiner, a

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telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (919) 854-1400.

Respectfully submitted,



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